REMARKS

These amendments and remarks are being filed in response to the Office Action dated October 6, 2004. For the following reasons this application should be allowed and the case passed to issue.

No new matter is introduced by these amendments. The amendment to the specification updates the priority information. Support for the amendment to claim 16 is supported by originally filed claims 19 and 20. Claims 18 and 20 are amended to maintain proper dependency. New claims 21 and 22 are supported by the specification at page 9, lines 11-15; and page 13, lines 1-28. Support for new claim 23 is found in originally filed claims 16, 19, and 20 and in the specification at page 9, lines 11-15; and page 13, lines 1-28. Originally filed claim 17 provides support for new claim 24.

Claims 16, 18, and 20-24 are pending in this application. Claims 16, 18, and 20 were rejected. Claims 1-15 have been previously canceled. Claims 17 and 19 have been canceled in this response. Claims 16, 18, and 20 have been amended in this response. Claims 21-24 are newly added.

Examiner's Comments

In response to the Examiner's Comments in the Office Action, Applicants note that pursuant to 35 U.S.C. § 112, sixth paragraph, the recited "means for facilitating release of said embossing surface" shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Claim Rejections Under 35 U. S. C. §§ 102 and 103

Claims 16, 19, and 20 were rejected under 35 U.S.C. § 102(b) as being anticipated by Takeoka et al. (U.S. Patent No. 4,845,000). This rejection is traversed, and reconsideration and

withdrawal thereof respectfully requested. The following is a comparison between the invention as claimed and the cited prior art.

An aspect of the invention, per claim 16, is a stamper for embossing a servo pattern in a surface of a layer of a hydrophilic sol-gel formed on a surface of a substrate for a magnetic recording medium, comprising a main body having an embossing surface including a negative image of the servo pattern. The main body is formed of a first metal. The stamper includes a means for facilitating release of the embossing surface of the stamper from the surface of the layer of sol-gel subsequent to embossing of the servo pattern. The embossing surface is formed of platinum, carbon, or a hydrophobic polymer.

The Examiner asserted that Takeoka et al. teach a stamper comprising a main body having an embossing surface including a negative image of servo patterns, and means for facilitating release of the embossing surface of the stamper from a layer subsequent to embossing the servo patterns. The Examiner further asserted that Takeoka et al. disclose the claimed first and second metals.

Takeoka et al., however, do not anticipate the claimed stamper. Takeoka et al. do not disclose a stamper comprising a main body formed of a first metal and an embossing surface formed of platinum, carbon, or a hydrophobic polymer, as required by claim 16. Contrary to the Examiner's assertions as regards claim 20, Takeoka et al. do not disclose an embossing surface formed of the claimed second metal, platinum.

Claims 16-19 were rejected under 35 U.S.C. § 102(b) as being anticipated by Zager et al. (U.S. Patent No. 5,552,009).

Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Zager et al.

These rejections are traversed, and reconsideration and withdrawal thereof respectfully requested.

The Examiner averred that Zager et al. disclose a stamper comprising a main body having an embossing surface including a negative image of servo patterns, and means for facilitating release of the embossing surface of the stamper from a layer subsequent to embossing the servo patterns. As regards claims 17 and 18, the Examiner further asserted that Zager et al. disclose that polycarbonate can be used as a substrate, and that Zager et al. further disclose hydrophilic and amorphous thermoplastic materials. As regards claim 19, the Examiner alleged that Zager et al. disclose a main body comprising a first metal and an embossing surface comprising a hydrophobic polymer (fluoropolymer). The Examiner asserted that it would have been obvious to form a stamper using nickel since nickel substrates were known in the art.

Zager et al., however, do not anticipate the claimed stamper. Zager et al. do not disclose a stamper comprising a main body formed of a first metal and an embossing surface formed of platinum, carbon, or a hydrophobic polymer, as required by claim 16.

Further, as regards claims 17 and 18, Zager et al. do not disclose stamper substrates formed of polycarbonate. Rather, Zager et al. disclose that the substrate of the optically readable medium can be formed of polycarbonate.

Contrary to the Examiner's assertion with respect to claim 19, Zager et al. do not disclose a stamper with a main body comprising a first metal and an embossing surface comprising a fluoropolymer. As disclosed in column 11, lines 14-16 and lines 25-33, Zager et al. teach an opaque metal on a glass or quartz body as one embodiment of a stamper and a photopolymerized body with a release coating as another embodiment of a stamper. The Examiner apparently

combined two different embodiments to reject claim 19. However, Zager et al. does not suggest combining these two different embodiments.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). There are significant differences between the claimed stamper and the stampers disclosed by Takeoka et al. and Zager et al. that would preclude the factual determination that Takeoka et al. and Zager et al identically describe the claimed stamper within the meaning of 35 U.S.C. § 102. As explained above, Takeoka et al. and Zager et al. do not disclose a stamper comprising a main body formed of a first metal and an embossing surface formed of platinum, carbon, or a hydrophobic polymer, as required by claim 16. Accordingly, the rejection under 35 U.S.C. § 102 is not legally viable and should be withdrawn.

Claim 20 is allowable for at least the same reasons as claim 16, as Zager et al. do not suggest a stamper comprising a main body formed of a first metal and an embossing surface formed of platinum, carbon, or a hydrophobic polymer.

The dependent claims are allowable for at least the same reasons as the claim 16, and further distinguish the claimed invention. For example, claim 18 further requires that the hydrophobic polymeric material polymer comprises an amorphous thermoplastic material. Claim 20 further requires the first metal is nickel and the embossing surface is formed of a sputtered hydrophobic polymer. The prior art does not suggest the claimed stamper with these additional limitations.

Applicants submit that new claims 21-24 are allowable over the prior art of record. The cited prior art does not suggest the claimed stamper with an embossing surface formed of platinum, carbon, a polycarbonate, a polyetherimide, a polypropylene, or a polyethylene.

In view of the above amendments and remarks, Applicants submit that this application should be allowed and the case passed to issue. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

Bernard P. Codd
Registration No. 46,429

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 BPC:kap
Facsimile: 202.756.8087
Date: January 6, 2005

Please recognize Customer No. 49745 as our correspondence address.